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Re

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,489	08/27/2001	James Malcolm Vignoles	01.018.01	2875
7590	08/15/2006		EXAMINER	
Zilka-Kotab, PC P.O. Box 721120 San Jose, CA 95172-1120			SCHUBERT, KEVIN R	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/938,489	VIGNOLES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Kevin Schubert	2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 July 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,9-14,21-26 and 33-37 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-2,9-14,21-26,33-37 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

Claims 1-2,9-14,21-26, and 33-37 have been considered. After careful review, Examiner believes the previous prior art rejections to have been overcome. However, a 101 issue is present.

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***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-2,9-14,21-26, and 33-37 are rejected under 35 U.S.C. 101. Regarding claims 1-2 and 9-12, Applicant discloses "a computer program product". The first issue is whether the claimed program product is limited to physical articles or objects to establish a statutory category of invention as a manufacture, since it's not a machine, process, or composition of matter. Absent an explicit and deliberate definition in the disclosure (which Examiner is unable to find), a program product is just the software piece and fails to include the physical article or object as the medium which establishes the statutory category. The second issue is whether the logic produces a useful, concrete, and tangible result. In this instance, the final result achieved is conditional. Therefore, Examiner has reviewed the final result achieved for each condition covered, both those actually recited and those covered but not recited. If any fail to be a useful, concrete, and tangible result, then the claims are properly rejected under 35 U.S.C. 101. In the instant case, Examiner believes claim 1 does not produce a useful, concrete, and tangible result in the instance when the update status of the current malware scanner matches the update status of the previous malware scanner. Based on the two issues presented above, claims 1-2 and 9-12 are rejected under 35 U.S.C. 101.

Claims 13-14 and 21-24 do not appear to have the first issue presented above, but like claim 1, a useful, concrete, and tangible result does not appear to exist in every instance of the conditional statements covered. Like claim 1, claim 13 does not appear to produce a useful, concrete, and tangible result in the instance when the update status of the current malware scanner matches the update status

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of the previous malware scanner. Based on this issue, claims 13-14 and 21-24 are rejected under 35 U.S.C. 101.

Claims 25-26 and 33-37 purport to be apparatus claims, but appear to be lacking an essential element under 112, 2<sup>nd</sup>, to support the preamble and make them apparatus claims. As such, they appear 5 to be merely software (functional descriptive material), *per se*, and non-statutory under 35 U.S.C. 101 rather than an actual apparatus. Claim 25 also appears to have the same issue of claim 1 and claim 13 regarding the conditional nature of the final result achieved. Based on these two issues, claims 25-26 and 33-37 are rejected under 35 U.S.C. 101.

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### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, 15 Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through 20 Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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KS

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER